

REMARKS

Applicant notes that all amendments and cancellations of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the amended or cancelled Claims (or similar Claims) in the future.

The Examiner has rejected Claims 1-3 and 5-12 under 35 USC §103 as allegedly being obvious in light of Shanahan et al., US Patent Publication 2005/0022114 (hereinafter Shanahan). The Applicants respectfully disagree. However, for business purposes and to further the prosecution of the present application, while reserving the right to prosecute the original or similar claims in the future, the Applicants have amended the claims to recite that the standardized formatted objects are images and that contextual markups are added as invisible images that map to the image file. The Applicants submit that Shanahan does not teach or suggest either that the standardized formatted objects are images or that contextual markups are added as invisible images that map to the image file.

In response to the Applicants' previous arguments, the Examiner states "Shanahan recites "document content is detected and converted to a digital form" (paragraph 179)"..." (Office Action, pg. 4). The Examiner further states "Shanahan discloses the standardized document as an image file..." "In its electronic form a document may include image data"..." (Office Action, pg. 5). The Applicants respectfully disagree and submit that a digital form is not the same as an image. In addition, the fact that a digital document may contain images does not teach or suggest the methods of the present invention which require that all of the documents be converted **entirely** into images or image files. Shanahan further does not teach or suggest the annotation of an **image** file. The Examiner has pointed to no teaching in Shanahan that teaches or suggests the annotation of standardized image files.

The Examiner further states "Shanahan recites "A meta-document 100, for example, may be given a personality 104 that is:... (c) private..."..." (Office Action, pg. 5). The Applicants respectfully disagree and submit that Shanahan does not teach or suggest contextual markups

¹ 65 Fed. Reg. 54603 (Sept. 8, 2000).

that are added to an invisible image that maps to an image file. The Examiner has provided no evidence that Shanahan teaches or contemplates adding invisible **image** layers to an **image** file.

The Applicants submit that the Examiner has not demonstrated a *prima facie* case of non-obviousness because Shanahan does not teach or suggest every element of the claimed invention. In addition, the Examiner has provided no evidence (explicit or implicit) as to why one of skill in the art would be motivated to modify the teachings of Shanahan to arrive at the presently claimed invention, nor does such a motivation exist. As such, the rejection under U.S.C. 103 is improper and the rejection should be withdrawn.

CONCLUSION

All grounds of rejection of the Office Action of April 2, 2008 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that the claims should be allowed. Should the Examiner have any questions, or if a telephone conference would aid in the prosecution of the present application, Applicants encourage the Examiner to call the undersigned collect at 608-218-6900.

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